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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,569	07/30/2003	Bernard Petillo		1568
28206	7590	10/01/2004		EXAMINER
RHODES INSTRUMENT CORPORATION 11 VIRGINIA ROAD N. WHITE PLAINS, NY 10603			TADESSE, YEWEBDART	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/604,569	PETRILLO ET AL.
	Examiner	Art Unit
	Yewebdar T Tadesse	1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 June 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference numbers 13-15 are not shown in the drawings filed on June 10, 2004. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. Claim 2 is objected to because of the following informalities: in claim 2, line 2; it appears the word "both" after the word "that" is a typographic/grammatical error. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 3-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed features (extraction system and the sensing device) recited in claims 3 and 4, are not described anywhere in the applicants' specification.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Amos et al (US 3,837,731). Amos et al discloses (see Fig 1 and column 1, lines 5-12) an immersion fluid (optical index oil) dispenser for microscopes depositing the proper amount of fluid on the specimen (slide 12). In the immersion optics application, optical oil is used as an immersion fluid, as shown – for instance by Hodges (US 5,066,114, see column 2, line 25).

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Reiner (US 6,196,686). Reiner discloses (see Fig. 1a and column 1, lines 32-42) an immersion fluid dispenser (hose 15) introducing fluid on the concave lens surface of the optical system (surgery microscopes).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Amos et al (US 3,837,731) as applied to claim 1 above and further in view of Fowler et al (US

5,574,594). Amos et al lacks teaching a two-stage mechanical support positioning the dispenser. Fowler et al teaches a two stage mechanical configuration (having parts 24 and 26) positioning the dispensing port (tube 58) from remote location (see Figs 1-2) in automated microscope marking device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include Fowler et al's two-staged mechanical configuration in Amos et al device to adjust the length of the hose (28) relative to the microscope as desired.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Amos et al (US 3,837,731) in view of Fowler et al (US 5,574,594) as applied to claims 1 and 2 above and further in view of Rolland et al (US 2004/0180299 A1). Amos et al as modified lacks teaching a fluid extraction system. Rolland et al (see paragraphs 5 and 40) teaches immersion lithography methods using the principles of immersion oil microscopy, wherein a fluid extraction system (carbon dioxide chamber) is used to remove the immersion fluid layer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the extraction capability of Rolland et al system in Amos et al's device to clean the deposition area.

12. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Amos et al (US 3,837,731) in view of Fowler et al (US 5,574,594) and Rolland et al (US 2004/0180299 A1) as applied to claim 1 and 2 above and further in view of Bowman et al (US 5,233,197). Amos et al as modified lacks teaching a sensing capability for its

device. Bowman discloses (see Fig 6 and column 8, lines 40-53) in a high-speed microscope, a sensor (128) in communication with a computer 11 to precisely determine the position of objective relative to the specimen. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the sensing capability of Bowman et al's device in Amos et al as modified to rapidly focus the objective at each new focal plane as taught by Bowman.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hodges (US 5,066,114) – teaching optical oil as immersion fluid.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yewebdar T Tadesse whose telephone number is (571) 272-1238. The examiner can normally be reached on Monday-Friday 8:00 AM-4: 30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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